

Exhibits**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARDName of Applicant: **Stephen M. Sacker**

Docket No.

Serial Number of Application: **75/835,499****SACK-0203**Filing Date of Application: **11/18/99**Trademark: **eMD**International Class(es): **042****03-25-2002**

U.S. Patent & TMO/TM Mail Rpt Dt. #11

NOTICE OF APPEAL

Applicant hereby appeals to the Trademark Trial and Appeal Board from the decision of the Trademark Examining Attorney refusing registration.

This Appeal is taken for:

☒ all classes listed above ☐ only the following classes: _____The total number of classes associated with this Appeal are: 1The prescribed appeal fee of **\$100.00** is to be paid as follows:☒ A check in the amount of **\$100.00** is attached.Any excess or insufficiency should be credited or debited to Deposit Account No. **19-0513**

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SignatureDated: **March 19, 2002**

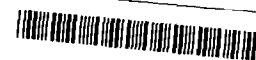
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Name of Applicant: **Stephen M. Sacker**

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Serial Number of Application: **75/835,499****SACK-0203**Filing Date of Application: **11/18/99**Trademark: **eMD**International Class(es): **042****03-25-2002**

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NOTICE OF APPEAL

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK EXAMINING OPERATION

In re the Application of: Stephen M. Sacker

Serial No.: 75/835,499

Docket Number: SACK-0203

Filed: November 18, 1999

Attorney: Barbara A. Loughran

Mark: eMD

Trademark Law Office: 101

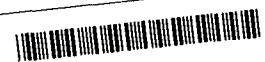
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Assistant Commissioner for Trademarks

2900 Crystal Drive

Arlington, VA. 22202-3513



03-25-2002

U.S. Patent & TMO/TM Mail Rpt Dt. #11

Dear Sir:

In response to the Office Action dated September 19, 2001 please amend the above-identified application as follows:

Amend the description of goods/services to read as follows:

-- Computer Services, namely providing an on-line computer database in the field of health care and medicine with associated medical diagnostic hardware and software for receiving medical condition and symptom data from users, analyzing the medical condition and symptom data received, and providing output from the computer database to the users in the form of potential medical diagnosis, treatment and collateral relating to the medical condition and symptom data, in International Class 42.--

REMARKS

Final Requirement for Acceptable Recitation of Services

In the office action dated September 19, 2001, the Examining Attorney refused the applicant's mark for registration. The Examining Attorney found that the language "on-line diagnostic services" was "very unclear" and did not allow the amended description of services.

In response to this rejection, Applicant has again amended its description of goods in response to the rejection and several telephone conferences with the Examining Attorney to comply with the Examining Attorney's requirement for a more "clear" description of services. The amended description of services falls within the original description of services, namely "providing a wide range of services and information through a multi-user global computer and communications network in the fields of healthcare, wellness and medicine", and is consistent with previous attempts to amend the description.

Applicant has chosen not to adopt the descriptive language proposed by the Examining Attorney because it does not fully describe the diagnostic nature of the proposed services. Applicant believes, based upon the telephone conferences with the Examining Attorney, that the amended description above clearly explains the nature of the services. Therefore, Applicant requests that the Examining Attorney remove this application from final status to consider Applicant's compliance with the Examining Attorney's requirement.

Final Requirement for Statement of Intended Services

In compliance with Examiner's requirement to submit explanatory materials and/or statements explaining the nature, purpose and channels of trade of the services intended to be offered under the mark, Applicant submits the following description of the intended use of the mark:

Applicant intends to provide a website at the web address WWW.EMD.COM. Using a user-friendly interface, the website will accept user input relating to particular medical conditions or the symptoms of particular medical conditions. User input may be in the form of traditional computer entry and may also use a specially "tuned" terminal for use by medical professionals. Hardware and software associated with the interface will receive and analyze the symptoms and signs of the medical conditions

provide further medical background and references on the diagnosed medical conditions, and may suggest various options for treatment and financial support. The relevant medical symptom, diagnosis, condition, treatment and other collateral and collateral references are included within a database associated with the hardware, software and user interface. The options for treatment and collateral may include references to specific physicians who may be specialists in a field, web site links, pharmaceuticals, trials, insurance providers, traditional therapies and non-traditional therapies. The collateral may also include recommendations for and access to blood tests, medical kits, medical equipment, testers and/or analyzers.

In light of this submission of the requested explanatory materials, Applicant requests that the Examining Attorney remove this application from final status to consider Applicant's compliance with the Examining Attorney's requirement.

Final Refusal of Registration in View of Registration No. 2129111

The Examining Attorney also refused registration under Section 2(d) of the Trademark Act, in light of U.S. Registration No. 2129111 and made that refusal FINAL. Applicant respectfully requests that the Examining Attorney remove this Application from FINAL status to consider the above amended description of goods and services and the additional descriptive material submitted in compliance with the Examining Attorney's requirements.

In determining the likelihood of consumer confusion, many factors must be considered (TMEP 1207.01) from *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973) including (1) the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression; (2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use; and (6) The number and nature of similar marks in use in similar goods. (Please note, other factors are identified in the TMEP 1207.01, but necessitate a discussion of facts that are not currently known by Applicant. Therefore, factors 3-5 and 7-13 will not be explored for the purposes of this office action response).

(1) the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.

The cited registration, "e.MD" is a stylized mark with a "dot" between the "e" and the "MD." The applicant mark, eMD does not use the "dot." While the Examining Attorney asserted that the presence of the "dot" between the "e" and the "MD" of the

registered mark was not sufficiently distinguishing, Applicant respectfully disagrees. The "dot" is an important distinction between the marks. As discussed more fully below, the "dot" distinguishes the marks visually, by sound and in connotation and commercial impression.

The marks look different. The registered mark is a stylized "e.MD", and Applicant's mark is "eMD," without an intervening "dot." While the extra visual spacing and design element provided by the "dot" between the "e" and "MD" in other contexts may seem minor, with a short mark, having an interruption between the "e" and the "MD" makes the mark appear different than without the interruption. Depending upon how the mark is used and how many other similar marks are in use, this small difference can have a significant affect on the commercial impression it provides.

The marks sound different. The registered mark is pronounced "E – DOT – MD" (as evidenced by the web address of the registered company "EDOTMD.COM," see Exhibit 1). Applicant's mark is pronounced "EMD", with no interruption between the three letters. Although the Examining Attorney stated in the Office Action that "the alleged manner of use of the mark of the cited registrant on its Internet site is not before us here," the Internet address adopted by the registrant clearly incorporates the punctuation and pronunciation of the mark and is evidence of registrant's own use of the sound or the intended sound of the cited mark. This difference in the sound of pronouncing the marks creates different distinct commercial impressions.

Particularly in light of the recent surge of the Internet and the modern commercial awareness of "dot"s in company names, a "dot" is no longer merely a punctuation, but has become a part of a company's identity (whether used on the Internet or in other contexts). The inclusion of a "dot" in a trademark with only three other characters is not identical to and, under circumstances such as those of the present case, is not even confusingly similar to a mark using the same three other characters without the interrupting "dot". This modern consumer awareness and understanding of the use of a "dot" should be considered in the analysis of the visual, audible and commercial impressions of the marks as a whole.

The similarity of the marks must also be considered in light of the way the marks are encountered in the marketplace *Lindy Pen Co., v. Bic Pen Corp.*, 725 R.2d 1240, 1245 (9th Cir. 1984). A consumer experiences the registered mark, as it is identified in the application and the registration, on a publication, namely, a magazine in the medical and health care fields (see description of goods and services, Registration No. 2129111). For example, a consumer experiencing the registered mark may see "e.MD" as a title on the front of a glossy magazine. The magazine might arrive in the consumer's mailbox or

the consumer may see the magazine at a news stand. Alternatively, a consumer may experience the registered mark on a flier for a continuing medical education seminar. The flier might also be a mailing which arrives in the consumer's mailbox.

Applicant's services would be encountered in the marketplace through the Internet in electronic form rather than in a mailbox in paper form. A consumer seeking to make use of the Applicant's services would access Applicant's medical diagnostic and database retrieval services through the Internet in response to entering symptoms at Applicant's intended Internet address "EMD.COM", and would receive specific collateral relating to those symptoms and conditions. A consumer seeking e.MD Magazine, if the consumer even expected to find it on the Internet, would not be confused into typing "EMD.COM", but would type "EDOTMD.COM" or "E.MD.COM" because the registered mark is not "EMD". The registered mark instead includes a significant interrupting "dot" between the "e" and the "MD". Because the services provided by Applicant's mark are not Magazine services, but are diagnostic database services, it would be clear to anyone who happened to run across Applicant's web site in the marketplace that Applicant's mark was not the source of the e.MD Magazine or the e.MD Medical Educational Conferences service provided by the registered mark.

The connotations and commercial impressions imposed by these two different types of services (a magazine service vs. a computer-based diagnostic/analytic service) are different. Although the two marks differ in appearance and sound by a "dot" and use three characters, the differences between "eMD" and "edotMD" are significant to the overall commercial impression of the mark. Applicant respectfully refers the Examining Attorney to the above amended descriptions of Applicant's goods and services and the additional descriptive material, provided in compliance with the Examining Attorney's request. Nevertheless, even if the "e.MD" mark were pronounced as "E-MD" rather than "edotMD", for the sake of argument only, because the nature of Applicant's services are so unrelated to the "e.MD" services and there are numerous other virtually identical marks in use in the medical field, as discussed further below, Applicant's mark should be allowed in association with Applicant's described services.

(2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.

The registered "e.MD" mark is for "a publication, namely, a magazine covering information in the medical and healthcare fields" in International Class 16, and for "arranging educational conferences in the medical and healthcare fields" in International Class 41.

The Applicant's mark is for "Computer Services, namely providing an on-line computer database in the field of health care and medicine with associated medical diagnostic hardware and software for receiving medical condition and symptom data from users, analyzing the medical condition and symptom data received, and providing output from the computer database to the users in the form of potential medical diagnosis, treatment and collateral relating to the medical condition and symptom data, in International Class 42."

Applicant respectfully submits that magazine services (Class 16) and services for arranging and conducting seminars (Class 41), even if the magazine and seminars deal with medical or healthcare information, are significantly different from the computer-based medical diagnostic database services (Class 42) recited in Applicant's Statement of Intended Services. A magazine includes publisher-chosen, predetermined articles which arrive in the mail or are purchased from a newsstand. Applicant's services electronically receive medical condition and symptom input from users and, based upon that input, provide potential diagnosis and medical collateral relevant to the medical condition or symptom data.

The nature of the services described in the registered mark and Applicant's application are dissimilar except that they both relate to the large and diverse health care field. While some magazine subscribers and educational conference attendees may also seek diagnostic services through the Internet, they would not seek those services from the registrant. The services of Applicant are substantially dissimilar to those of the registrant and would not give rise to a mistaken belief that the services come from a common source. In light of the differences in the commercial impressions the two marks make, and the abundance of other similar marks in related health care fields, as discussed below, it is not likely that a consumer would confuse Applicant's mark with the cited registered mark.

(6) The number and nature of similar marks in use in similar goods.

In addition to the "e.MD" registration No. 2129111 for healthcare Magazines, there is also a registration to a different registrant for "E.MD" for a global information network for the transfer and dissemination of data including medical images and personal medical information (Registration No. 2353909) (Exhibit 2). Furthermore, as is attached hereto as Exhibits 3-9, numerous other unregistered "EMD" marks are currently used in the healthcare industry. The examples provided in Exhibits 3-9 are only a sample of what is currently being used in the healthcare industry to emphasize that because numerous "EMD" marks are already being used in the healthcare industry, the difference between a healthcare magazine service using "e.MD" and a medical diagnostic database service using "eMD" is significant.

Examples provided for EMD currently being used within the health care field include EMD services for pharmaceuticals (Ex. 3), medical degree information (Ex. 4), medical laboratory education and management (Ex. 5, select pages), medical emergency dispatch (Ex. 6), brain tumor testing (Ex. 7), muscular dystrophy information (Ex. 8), and medical payment/informational databases for use by medical clinics (Ex. 9). Additionally, there are endless examples of other EMD services which relate to commercial fields other than health care. Some examples of these relate to locomotives, informational computer services, music, electric motors, architects, electronics, magazines, military, market development, and many other types of services. See Exhibit 10, including the first 80 of 202,000 hits when searching for "emd." Rather than overload the Examining Attorney with specific prints of each of these web pages, Applicant will use this summary of hits to make its point that the mark "EMD" and its variations, are used extensively for a wide variety of goods and services, including many goods and services in the health care field.

The greater the number of similar marks already in use on different kinds of goods, the less is the likelihood of confusion between any two specific uses of the weak mark *First Savings Bank F.S.B. v. First Bank System, Inc.*, 101 F.3d 645, 40 U.S.P.Q.2d (BNA) 1865, (1996, District of Kansas). The great number of uses of the letters "EMD" for all kinds of goods and services, as evidenced by the appended materials, indicates that there is less of a likelihood of confusion between the registered "e.MD" mark for a magazine and Applicant's "eMD" mark for a diagnostic database.

Because of the large number of uses of the letters "EMD" and "E.MD" for a large array of goods and services, minor alterations in the marks may effectively negate any confusing similarity between the two marks. *First Savings Bank* at 655. Such minor alterations, i.e. the presence or absence of a "dot" in a short mark, should be considered

more significant in determining the similarities between the marks in a crowded field.

Other Considerations

Additionally, though Applicant is experiencing unavoidable delays due to Court schedules, Applicant is in the process of obtaining the rights to the common law trademark eMD for Applicant's services, including the domain name and rights to the mark which may be tacked back to use before the registered mark "e.MD". Applicant has invested significant resources into obtaining these rights which will be much less valuable without the federal trademark registration. Applicant's services are clearly not magazine or educational conference services and should be entitled to a registration.

CONCLUSION

In summary, Applicant has amended the subject application to comply with the Examining Attorney's requirements to amend the description of goods and services to make the description more clear. Applicant has also complied with the Examiner's requirements to include an additional statement to describe the intended use of the mark and additional information regarding extensive third party uses the letters "EMD" to describe many kinds of goods and services. Applicant, therefore, respectfully requests that the Final rejections of the application be withdrawn and that the application be allowed.

The cited mark and Applicant's mark are not identical. In light of the many third party uses of the letters "EMD," many in the medical and healthcare fields, the visual, audible and commercial impression differences between the cited registered mark and Applicant's mark, specifically the "dot," effectively negate any confusing similarity between the two marks. Furthermore, the nature of the goods and services of the cited registered mark, a magazine, and Applicant's mark, an on-line diagnostic database service, are not confusingly similar.

Accordingly, it is believed that the applicant has addressed and complied with the Examiner's rejection and favorable action is earnestly requested.

Respectfully submitted,



Kenneth C. Booth
Reg. No.42,342

Date: March 19, 2002
Schmeiser, Olsen & Watts LLP
18 East University Drive, #101
Mesa, Arizona 85201
(480) 655-0073

I HEREBY CERTIFY THAT THE CORRESPONDENCE TO WHICH THIS STATEMENT IS AFFIXED IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE, POSTAGE PAID AS FIRST CLASS MAIL, IN AN ENVELOPE ADDRESSED TO ASSISTANT COMMISSIONER FOR TRADEMARKS, 2900 CRYSTAL DRIVE, ARLINGTON, VA 22202-3513

On: March 19, 2002

Signature: Harsh Clark

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Mark: eMD

Applicant: Stephen M. Sacker

Assistant Commissioner for Trademarks

Box TTAB Fee

2900 Crystal Drive

Arlington, Virginia 22202-3513



03-25-2002

U.S. Patent & TMO/TM Mail Rpt Dt. #11

Dear Sir:

The undersigned, on behalf of applicant, submits herewith an amendment to the trademark application for registration of the above-referenced mark on the Principal Register.

Enclosed please find:

- 1) Postcard;
- 2) Office Action Response;
- 3) Notice of Appeal; and
- 4) Check in the amount of \$100.00.

Respectfully submitted,

Kenneth C. Booth

Reg. No. 42,342

Date: March 19, 2002

Schmeiser, Olsen & Watts LLP

18 East University Drive, #101

Mesa, Arizona 85201

(480) 655-0073

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ON: March 19, 2002

SIGNATURE: